

REMARKS

In an Office Action mailed on September 9, 2003, claims 1-27 were rejected under 35 U.S.C. § 112, first paragraph; claims 1-12 and 16-20 were rejected under 35 U.S.C. § 102(e) as being unpatentable over Nikander; and claims 13-15 and 21-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nikander. These rejections are addressed below.

The Examiner contends that claims 1-27 fail to satisfy the written description requirement of 35 U.S.C. § 112. Final Office Action, p. 3. With these rejections, the Examiner has effectively set forth a requirement that claim language, such as "computer peripheral device," must literally appear in the specification to satisfy the written description requirement of 35 U.S.C. § 112. However, contrary to the Examiner's position, a claim limitation does not need to be described literally in the specification to satisfy the written description requirement. *Nelson v. Bower*, 1 USPQ2d. 2076, 2078 (Bd. Pat. App. & Int'f 1986) (holding, "it is not necessary that the claimed subject matter be described in *ipsis verbis* to satisfy the written description requirement of 35 USC 112").

There is a strong presumption that an adequate written description of the present of the claimed invention is present when the application is filed. *In Re Wertheim*, 191 USPQ 90, 97 (CCPA 1976). To rebut this presumption, the Examiner merely relies on the argument that "network controller," instead of a "computer peripheral device," is explicitly recited in the specification. However, this is not a sufficient basis by itself to reject the claims for allegedly failing to comply with the written description requirement set forth by 35 U.S.C. § 112.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail so that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d. 1111, 1116 (Fed. Cir. 1991). The specification of the present application fulfills this requirement. In this manner, the specification describes at least one embodiment of a "computer peripheral device." For example, in lines 11-18 on page 4 of the specification, the specification describes a network controller 52 that may be implemented, as set forth in the specification, purely in hardware, or a combination of hardware and firmware or software. Specification, lines 11-18, p. 4. Furthermore, in lines 23-31 on page 5 of the specification and continuing on lines 1-3 on page 6 of the specification, the specification describes that the network controller 52 may be

used by application processes aside from processes that need to perform secure communications over the network. The specification describes that that network controller 52 may be used for a secondary use processes. The specification sets forth that such secondary use processes may include the encryption of file systems, securing e-mail, securing a remote procedure call (RPC), etc. Specification, lines 23-31, p. 5 - lines 1-3, p. 6. Additionally, Figure 2 depicts the network controller 52 being connected to a PCI bus 72 and to a network line 53. Thus, one skilled in the art would recognize that the network controller 52 constitutes an embodiment of a "computer peripheral device."

Attached hereto as Exhibit A is an excerpt from FOLDOCS, an online dictionary of computer-related terms, defining "peripheral device." As can be seen, a "peripheral device" is a device of a computer other than the CPU or main working memory. Thus, the network controller 52 described in the specification is one embodiment of a "computer peripheral device," thereby satisfying the written description requirement of 35 U.S.C. § 112.

As best understood by the undersigned, the Examiner's position is that because the exact phrase "computer peripheral device" does not appear in the specification, the specification does not meet the written description requirement. However, section 112 does not require that the exact same words in a claim have to appear in the specification. *Nelson*, 1 USPQ2d. at 2078.

It is noted that claims 1-27 are fully enabled by the description of the network controller 52 in the specification and the written description requirement has been satisfied, once it is appreciated that the network controller 52 is an embodiment of a "computer peripheral device."

Thus, for at least the reasons set forth above, withdrawal of the § 112, first paragraph rejections of claims 1-27 is requested.

Regarding the §§ 102 and 103 rejections of claims 1-27, the Examiner contends that, "a gateway or CPU and a computer peripheral device provides equivalent functions, thus does not constitute a patentable distinction." Office Action, 14. However, alleged equivalency is not a proper basis for ignoring claim limitations for purposes of determining whether a reference anticipates a claim. Rather, in judging the patentability of a claim against the prior art, the Examiner must consider all claim limitations. When all limitations of claims 1-27 are considered and are assigned the patentable weight that they are due, claims 1-27 overcome the §§ 102 and

103 rejections in view of Nikander, for at least the reasons set forth in the previous Reply, as Nikander fails to teach or suggest the "computer peripheral device" of these claims.

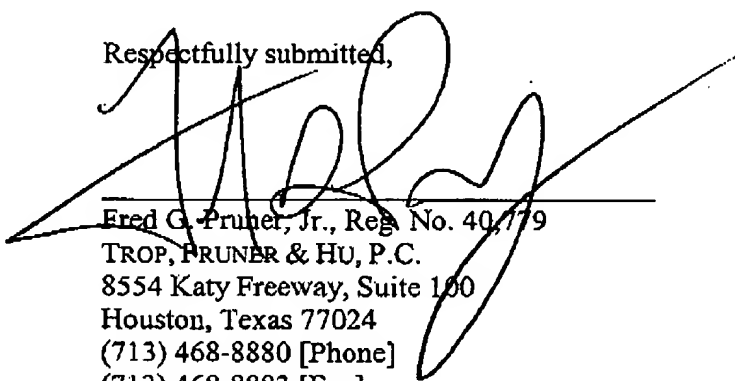
Thus, withdrawal of the §§ 102 and 103 rejections of claims 1-27 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 112, 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0182US).

Respectfully submitted,

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